

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on November 17, 2004, and the references cited therewith.

No claims are amended, canceled, or added; as a result, claims 1-56 are now pending in this application.

The Office Action fails to state any grounds for a rejection of claims 28 and 36. Therefore, Applicant respectfully request that the next communication state that claims 28 and 36 are allowed.

§102 Rejection of the Claims

Claims 1, 3, 5, 8, 10, 14, 15, 18, 20-24, 27, 31, 33, 43, 46, 47, 52, 55, and 56 were rejected under 35 U.S.C. § 102(b) as being anticipated by Collins *et al.* (U.S. 6,018,125). Applicant traverses the rejection of claims 1, 3, 5, 8, 10, 14, 15, 18, 20-24, 27, 31, 33, 43, 46, 47, 52, 55, and 56 because the Office Action fails to state a *prima facie* case of anticipation with regards to these claims.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131.

In addition, "For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art . . . Although this disclosure requirement presupposes the knowledge of one skilled in the art of

the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there." *Motorola, Inc. v. Interdigital Tech. Corp.*, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997).

In the present application, claim 1 recites, "an absorber layer covering at least a portion of each contiguous inner surface and capable of absorbing electromagnetic radiation over a select frequency range." Claims 13 recites, "an absorber layer covering at least a portion of each contiguous inner surface, the absorber layer capable of absorbing electromagnetic radiation over a select frequency range." Claim 19 recites, "an absorber layer covering at least a portion of each contiguous inner surface, the absorber layer capable of absorbing the EMI." Claim 23 recites, "each waveguide cell having an aperture leading from the interior and a contiguous inner surface at least partially coated with an absorber layer that absorbs the EMI over the select frequency range." Claims 27 recites, "absorbing waveguide means covering at least a portion of the substrate for absorbing electromagnetic radiation over a select frequency range." Claim 46 recites, "wherein the vent includes an EMI-absorbent material capable of absorbing electromagnetic radiation over a select frequency range." (emphasis added in all instances)

In an attempt to supply these elements as recited in claims 1, 13, 19, 23, 27, and 46, the Office Action relies on Collins *et al.*, column 2, lines 60-61 which states, "A conductive layer is coated on at least a surface of the non-conductive plate interior to the enclosure and on the walls of the tunnel openings." (emphasis added) The conductive layer of Collins *et al.* is described at column 2, line 66 through column 3, line 2 which states, "A copper layer is plated on at least a surface of the non-conductive plate interior to the enclosure and on the walls of the tunnel openings. A nickel layer is plated on the copper layer." Hence, there is no teaching in Collins *et al.* of "an absorber layer" or an "absorbing waveguide means" or "EMI-absorbent material" capable of absorbing electromagnetic radiation as recited in the claims as quoted above. Thus, Collins *et al.* fails to disclose each and every element of the claims 1, 13, 19, 23, 27, and 46 with sufficient clarity to prove the existence in the prior art of these elements, as recited in the claims. Therefore, the Office Action fails to state a *prima facie* case of anticipation with regards to claims 1, 23, 27, and 46.

Claims 3, 5, 8, and 10 depend from independent claim 1; claims 14-15, 18, and 20 depend from independent claim 13; claims 21-22 depend from independent claim 19; claim 24

depends from independent claim 23; claims 31, 33, and 43 depend from independent claim 27; claims 47, 52, and 55-56 depend from independent claim 46; and therefore include all the elements of the independent claim from which they depend. For reasons analogous to those stated above and elements in the claims, Applicant respectfully submits that the Office Action fails to state a *prima facie* case of anticipation with respect to claims 3, 5, 8, 10, 14-15, 18, 20-22, 24, 31, 33, 43, 47, 52, and 55-56.

For at least the reasons stated above, Applicant respectfully requests withdrawal of the rejections and reconsideration and allowance of claims 1, 3, 5, 8, 10, 14, 15, 18, 20-24, 27, 31, 33, 43, 46, 47, 52, and 55-56.

The Office Action on page 5 in the "Response to Arguments" section states, "The material used by Collins (nickel over copper) conducts, reflects and absorbs to some degree all electromagnetic radiation." Further, on page 6 the Office Action states, "Therefore, because any conductor absorbs to some degree, it meets the claimed limitations." Applicant respectfully disagrees. To serve as an anticipation when a reference is silent about the asserted inherent characteristic, the gap in the reference may be filled with recourse to extrinsic evidence. But, such evidence must make clear that "the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Applicant respectfully submits that the Office Action has not produced extrinsic evidence to show that "(nickel over copper) conducts, reflects and absorbs to some degree all electromagnetic radiation" or that "any conductor absorbs to some degree," or that these elements are necessarily present in Collins *et al.*

Therefore, Applicant disagrees with these statements and submits that since the Office Action does not recite a reference that discloses the elements cited in the claims, the correlation stated in the Office Action is within the personal knowledge of the Examiner. Thus, the Examiner is taking official notice with respect to these elements as recited in the claims. Applicant traverses the taking of official notice and requests that the Examiner provide a reference that describes the missing elements as recited in claims 1, 3, 5, 8, 10, 14, 15, 18, 20-24, 27, 31, 33, 43, 46, 47, 52, and 55-56. If the Examiner cannot provide such a reference, Applicant requests that the Examiner submit an affidavit as required by MPEP § 2144.03. If the Examiner

cannot provide an affidavit, Applicant requests withdrawal of the rejections and reconsideration and allowance of claims 1, 3, 5, 8, 10, 14, 15, 18, 20-24, 27, 31, 33, 43, 46, 47, 52, and 55-56.

§103 Rejection of the Claims

Regarding Claims 9, 12, 13, 16, 19, 34, 39-42, 44-45, and 48-50

Claims 9, 12, 13, 16, 19, 34, 39-42, 44-45, and 48-50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Collins *et al.* Applicant respectfully traverses the rejection of claims 9, 12, 13, 16, 19, 34, 39-42, 44-45, and 48-50 because the Office Action fails to state a *prima facie* case of obviousness with respect to claims 9, 12, 13, 16, 19, 34, 39-42, 44-45, and 48-50.

The Office Action on page 3 states,

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to a specific material for manufacturing a product, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of engineering choice.

Also on page 3 the Office Action states,

It would have been obvious to one of ordinary skill in the art at the time of the invention was made use a specific dimension, since such a modification would have been involved a mere change in size of a component. A change in size is generally recognized as being within the level of the ordinary skill in the art.

Applicant respectfully disagrees and objects to the taking of official notice in a single reference obviousness rejection; and pursuant to M.P.E.P. § 2144.03, Applicant traverses the assertion of official notice and requests that the Examiner cite a reference that teaches the missing elements. If the Examiner cannot cite a reference that teaches the missing elements, Applicant respectfully requests that the Examiner provide an affidavit describing how the missing elements are present in the prior art. If the Examiner cannot cite a reference or provide an affidavit, Applicant requests withdrawal of the rejections and reconsideration and allowance of claims 9, 12, 13, 16, 19, 34, 39-42, 44-45, and 48-50.

For reasons analogous to those stated above, Collins *et al.* fails to teach or suggest each of the elements of claims 1, 13, 19, 27, and 46. In addition, claims 9, 12, and 45 depend from independent claim 1; claim 16 depends from independent claim 13; claims 34, 39-42, and 44

depends from independent claim 27; claims 48-50 depend from independent claim 46; and therefore include all the elements of the independent claim from which they depend. For reasons analogous to those stated above and elements in the claims, Applicant respectfully submits that the Office Action fails to state a *prima facie* case obviousness with respect to claims 9, 12, 13, 16, 19, 34, 39-42, 44-45, and 48-50.

For at least the reasons stated above, Applicant respectfully requests withdrawal of the rejections and reconsideration and allowance of claims 9, 12, 13, 16, 19, 34, 39-42, 44-45, and 48-50.

Regarding Claims 2, 4, 7, 12, 15, 29-30, 35, 37-38, and 53-54

Claims 2, 4, 15, 35, 12, and 53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Collins *et al.* in view of Mitchell (U.S. 6,426,459). Further, the Office Action on page 4 rejects claim 54 under Collins *et al.* as modified by Mitchell. Still further, the Office Action on page 4 rejects claims 7, 29, 30, 37, and 38 under Collins *et al.* as modified by Mitchell. Applicant respectfully traverses the rejection of claim 2, 4, 7, 12, 15, 29-30, 35, 37-38, and 53-54 because the Office Action fails to state a *prima facie case* of obviousness with regards to these claims.

The Office Action must provide specific, objective evidence of record for a finding of a teaching, suggestion, or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action, in an attempt to meet this requirement, on page 3, states,

"It would have been obvious to a person having ordinary skill in the art at the time invention was made to use the shield design of Mitchell for the shield design of Collins *et al.* for the purpose of improving ventilation [sic]."

Further, the Office Action on page 4 states,

However, it would have been obvious to modify Collins *et al.* as modified by Mitchell by having a specific shapes [sic] cell with different type of configurations since applicant have presented no explanation that these particular configurations of the cells are significant or are anything more than one of numerous configuration a person of ordinary skill in the art would find obvious for the purpose of providing a cross section between two walls. A change in

shape is generally reconginizing [sic] as being within the level of ordinary skill in the art."

Applicant disagrees with these statements, and further submits that the statements are not supported by the record, as required by *In re Sang Su Lee*. Mitchell describes an EMI shielded vent wherein the specification of Mitchell at column 6, lines 1-15 states,

Electrically-conductive media 20 extends along a transverse axis, 50, intermediate a pair of opposing faces, 52a-b, defining a thickness dimension, d, therebetween which may range, typically, between about 1/64-1.5 inch (0.4-38 mm). Although media 20 may be provided as a metal screen or expanded metal mesh, it more preferably is provided, as is shown in FIG. 2, as one or more layers of a honeycomb material having a hexagonal or other cellular structure which is "open" or otherwise porous to admit the flow of cooling air therethrough for the ventilation of the associated housing or other electronics enclosure. Such cellular structure of media 20, which may be formed from a corrugated sheet of a 1-5 mil (0.039-0.197 mm) thick aluminum or other metal foil, or otherwise as is described in U.S. Pat. Nos. 3,821,463, 5,895,885; and 5,910,639, includes a plurality of cells, one of which is referenced at 54. (emphasis added)

In contrast, Collins *et al.* at column 2, lines 43-52 states,

With the above criteria in mind, a metal honeycomb mesh could be selected for the front wall of an enclosure by the diameter of the holes in the honeycomb mesh and the thickness of the honeycomb. The difficulty in solving the EMI shielding and air flow problem in this manner is that the honeycomb metal shield is extremely expensive and is also quite heavy for commercial applications. Therefore, what is needed is a lightweight, low cost electromagnetic shield with good airflow for application to an enclosures for electronic devices. (emphasis added)

Therefore, Collins *et al.* specifically teaches away from the use of the type structure disclosed in Mitchell, namely, Collins *et al.* teaches away from the use of a honeycomb metal shield as disclosed in Mitchell. Further, the very evidence the Office Action states is lacking regarding an "explanation that these particular configurations of the cells are significant or are anything more than one of numerous configuration a person of ordinary skill in the art would find obvious" is found in Collins *et al.* at column 2, lines 47-49 wherein "the honeycomb metal shield is extremely expensive and is also quite heavy for commercial applications." Therefore, the statements made in the Office Action to combination Collins *et al.* and Mitchell are not supported by the record, and therefore do not meet the standard of *In re Sang Su Lee*. By failing to meet the standard of *In re Sang Su Lee*, the Office Action fails to state a *prima facie* case of obviousness with regards to claims 2, 4, 7, 12, 15, 29-30, 35, 37-38, and 53-54.

Even assuming *arguendo* that Collins *et al.* and Mitchell are not improperly combined, the Office Action still fails to state a *prima facie* case of obviousness with respect to claims 2, 4, 7, 12, 15, 29-30, 35, 37-38, and 53-54.

As noted above, Collins *et al.* fails to teach an absorber capable of absorbing electromagnetic radiation as recited the claims 1, 13, 27, and 46 of the present application. In addition, Mitchell describes an EMI shielded vent having an electrically conductive porous shielding member (Co. 3, lines 9-15) such as cellular aluminum or metal honeycomb (Col 3 lines 36-37). There is no mention in Mitchell of an absorbing layer capable of absorbing electromagnetic radiation. Therefore, neither Collins *et al.* nor Mitchell teach or suggest, either alone or in combination, each of the elements of claims 1, 13, 27, or 46. Claims 2, 4, 7, 12, 15, 29-30, 35, 37-38, and 53-54 depend from one of independent claims 1, 13, 27, and 46, and therefore include all the elements of the independent claim from which they depend. Hence, the Office Action fails to state a *prima facie* case of obviousness with regards to claims 2, 4, 7, 12, 15, 29-30, 35, 37-38, and 53-54.

Further, with regards to claims 7, 29, 30, and 37-38, Applicant respectfully objects to the taking of official notice (page 4, second paragraph of the Office Action) and pursuant to M.P.E.P. § 2144.03, Applicant traverses the assertion of official notice and requests that the Examiner cite a reference that teaches the missing elements of claims 7, 29, 30, and 37-38. If the Examiner cannot cite a reference that teaches the missing elements, Applicant respectfully requests that the Examiner provide an affidavit describing how the missing elements are present in the prior art. If the Examiner cannot cite a reference or provide an affidavit, Applicant requests withdrawal of the rejections and reconsideration and allowance of claims 7, 29, 30, and 37-38.

For at least the reasons stated above, Applicant respectfully requests withdrawal of the rejections and reconsideration and allowance of claims 2, 4, 7, 12, 15, 29-30, 35, 37-38, and 53-54.

Regarding Claims 6, 17, 25-26, 32, and 51

Claims 6, 17, 25, 32, and 51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Collins *et al.* as modified by Mitchell in view of Clements *et al.* (U.S.

6,809,254). Applicant respectfully traverses the rejection of claims 6, 17, 25-26, 32, and 51 because the Office Action fails to state a *prima facie* case of obviousness with respect to these claims.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). Applicant submit that the statement on page 4 of the Office Action -- "It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use an absorbing layer having a thickness between .025 mm and .25 mm as teach by Clements et al. with Collins et al. as modified by Mitchell to effectively provide EMI shielding" -- fails to state a specific reason why it would be obvious to combine the references, and is mere speculation using impermissible hindsight in order to reconstruct the claimed invention. Therefore, the Office Action fails to state a *prima facie* case of obviousness with regards to claims 6, 17, 25, 32, and 51.

In addition, claims 6 and 17 recite, "wherein the absorber layer has a thickness between about 0.025 millimeters to about 0.25 millimeters." Claim 25 recites, "forming the absorber layer to have a thickness between about 0.025 millimeters and 0.25 millimeters." Claim 32 recites, "wherein the absorbing means has a thickness between about 25 micrometers and 250 micrometers." Claim 51 recites, "wherein the absorbent surface layer has a thickness between about 25 micrometers and about 250 micrometers." The Office Action admits that neither Collins *et al.* nor Mitchell disclose these elements, but relies on the shield layer 14 of Clements *et al.* as disclosing these elements. Applicant disagrees. Clements *et al.* fails to teach or suggest an "absorbing layer" of any kind. In contrast, Clements *et al.* at column 3, line 64 through column 4, line 2 states,

Depicted in FIG. 1 is an oblique view of an EMI-attenuating air ventilation panel 1 for an electronic device enclosure. The ventilation panel includes an electrically conductive panel 10 having an air ventilation hole 12 formed in it. FIG. 2 is a side view of the ventilation panel and depicts an electrically conductive tube 14 which is electrically and mechanically coupled to the electrically conductive panel at the periphery 15 of an air ventilation hole.

Therefore, neither Collins *et al.*, nor Mitchell, nor Clement *et al.*, either alone or in combination,

teach or suggest each of the elements recited in claims 6, 17, 25, 32, and 51. Thus, the Office Action fails to state a *prima facie* case of obviousness with regards to claims 6, 17, 25, 32, and 51.

Further, regarding claim 26, Applicant disagrees with the statement on page 5 of the Office Action "to use screws to attach the shielding to the chassis would have been obvious in order to securely mounted the shield thereto," and assumes that since no reference is cited that teaches or suggests these elements as recited in claim 26, the Examiner is taking official notice of these elements. Applicant traverses the assertion of official notice and requests that the Examiner cite a reference that teaches the missing elements. If the Examiner cannot cite a reference that teaches the missing elements, Applicant respectfully requests that the Examiner provide an affidavit that describes how the missing elements are present in the prior art. If the Examiner cannot cite a reference or provide an affidavit, Applicant requests withdrawal of the rejection and reconsideration and allowance of claim 26.

For at least the reasons stated above, Applicant respectfully requests withdrawal of the rejections and reconsideration and allowance of claims 6, 17, 25-26, 32, and 51.

Regarding Claim 11

Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Collins *et al.* in view of Narang *et al.* (U.S. 5,976,666). Applicant respectfully traverses the rejection of claim 11 because the Office Action fails to state a *prima facie* case of obviousness with regards to claim 11.

As noted in the Applicant's response to the previous Office Action (the Office Action being mailed on October 21, 2003):

Claim 11 was rejected under 35 USC § 103(a) as being unpatentable over Collins et al. in view of Narang et al. (U.S. 5,976,666). Applicant respectfully traverses. Narang discusses (but has no drawings) a perforated absorber layer, but only as laminated to a metal (i.e., conductive) plate, not an insulating vented substrate. Further, although the perforations (e.g., col. 12 lines 34-49) and plate (col. 12 lines 5058) are described somewhat (without Figures), Applicant cannot find a description that indicates the metal plate itself is perforated, or vented, or allowing flow of heat. Thus, there appears to be no motivation to combine, as suggested by the Examiner, an absorbing layer stripped off a metal plate from Narang, and instead applied to an insulating grid instead of the metal layer

described by Collins. Further, claim 11 depends from independent claim 1 that, for the reasons discussed above appears to be in condition for allowance. Accordingly, claim 11 appears to be in condition for allowance, and reconsideration and withdrawal of the rejection is respectfully requested.

The present Office Action (mailed November 11, 2004) does not address any of these arguments. Therefore, Applicant submits that for the reasons stated above, the Office Action fails to state a *prima facie* case of obviousness with regards to claim 11. For at least the reasons stated above, Applicant respectfully requests withdrawal of the rejection and reconsideration and allowance of claim 11.

Reservation of Rights

Applicant does not admit that references cited under 35 U.S.C. §§ 102(a), 102(e), 103/102(a), or 103/102(e) are prior art, and reserves the right to swear behind them at a later date. Arguments presented to distinguish such references should not be construed as admissions that the references are prior art.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((612) 373-6902) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

STEVE Y. CHANG ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
Attorneys for Intel Corporation
P.O. Box 2938
Minneapolis, Minnesota 55402
(612) 349-9592

Date May 17, 2005

By Ann M. McCrackin
Ann M. McCrackin
Reg. No: 42,858

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 17th day of May, 2005.

Amy Moriarty
Name

Amy Moriarty
Signature